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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,947	07/25/2001	Bjorn Dahlback	INL-036DV	7730

21323 7590 07/10/2003

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON, MA 02110

EXAMINER

WHISENANT, ETHAN C

ART UNIT	PAPER NUMBER
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1634

15

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/912,947	Applicant(s) DAHLBACK, BJORN	
	Examiner Ethan Whisenant, Ph.D.	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/500,917.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

1. Applicant's election of Group I (**Claims 40-42 and 44-52 – involving nucleic acid analysis**) with traverse in Paper No. 14 is acknowledged. It is noted that the applicant has traversed the restriction requirement, however, because the applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The restriction requirement has been reconsidered, is deemed proper and is, therefore, herein made **FINAL**.

OATH OR DECLARATION

2. The oath or declaration is missing. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

It is noted that the transmittal papers filed 25 JUL 01 indicate that a copy of the oath/declaration filed in 08/500,917 is included. However, the file wrapper does not contain said oath/declaration. Please provide a copy.

35 USC § 112 - 1ST PARAGRAPH

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

CLAIM REJECTIONS under 35 USC § 112- 1ST PARAGRAPH

4. Claim(s) 40-52 is/are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the invention.

The claimed invention is directed to a method of determining if an individual is at risk of developing thrombosis by detecting a mutation in the Factor V/Va gene/mRNA. However, it appears, that the applicant has not actually found a mutation but rather linkage between a neutral polymorphism in the Factor V gene and expression of APC-resistance. The applicant states that "this strongly suggests that a mutation in the Factor V gene is the cause for APC-resistance." Note especially page 20 of the specification. This statement is not an adequate disclosure to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the invention. This statement alone makes it clear that the claimed invention had not reduced to practice at the time the application was filed.

In support of this position, attention is directed to the decision of *Fiers v. Sugano* 25 USPQ2d 1604-5 (CAFC, January 1993) wherein is stated:

We also reject *Fiers* argument that the existence of a workable method for preparing a DNA establishes conception of that material. Our statement in *Amgen* that conception may occur, *inter alia*, when one is able to define a chemical by its method of preparation requires that the DNA be claimed by its method of preparation. We recognize that, in addition to being claimable by structure or physical properties, a chemical material can be claimed by means of a process. A product-by-process claim normally is an after-the-fact definition, used after one has obtained a material by a particular process. Before reduction to practice, conception only of a process for making a substance, without a conception of a structural or equivalent definition of that substance, can at most constitute conception of the substance claimed as a process. Conception of a substance claimed *per se* without reference to a process requires conception of its structure, name, formula, or definitive chemical or physical properties.

* * * *

The difficulty that would arise if we were to hold that a conception occurs when one has only an idea of a compound, defining it by its hoped-for function, is that would-be inventors would file patent applications before they had made their inventions and before they could describe them. That is not consistent with the statute or the policy behind the statute, which is to promote disclosure of inventions.

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Attention is also directed to a more recent decision: *The Regents of the University of California v. Eli Lilly and Company* (CAFC, July 1997) wherein is stated:

In claims involving chemical materials, generic formulas usually indicate with specificity what the generic claims encompass. One skilled in the art can distinguish such a formula from others and can identify many of the species that the claims encompass. Accordingly, such a formula is normally an adequate written description of the claimed genus. In claims to genetic material, however, a generic statement such as "vertebrate insulin cDNA" or "mammalian cDNA," without more, is not an adequate written description of the genus because it does not distinguish the claimed genus from others, except by function. It does not specifically define any of the genes that fall within its definition. It does not define any structural features commonly possessed by members of the genus that distinguish them from others. One skilled in the art therefore cannot, as one can do with a fully described genus, visualize or recognize the identity of the members of the genus. A definition by function, as we have previously indicated, does not suffice to define the genus because it is only an indication of what the gene does, rather than what it is. See Fiers, 984 F.2d at 1169-71, 25 USPQ2d at 1605-06 (discussing Amgen). It is only a definition of a useful result rather than a definition of what it achieves as a result. Many such genes may achieve that result. The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See In re Wilder, 736 F.2d 1516, 222 USPQ 369, 372-373 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate."). Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material.

Thus, as we have previously held, a cDNA is not defined or described by the mere name "cDNA," even if accompanied by the name of the protein that it encodes, but requires a kind of specificity usually achieved by means of the recitation of the sequence of nucleotides that make up the cDNA. See Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606.

CONCLUSION

5. Claim(s) 40-52 is/are rejected and/or objected to for the reason(s) set forth above.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.



**ETHAN WHISENANT
PRIMARY EXAMINER**

SEARCH NOTES

07 JUL 03

09/912,947

Databases searched: USPATFULL via EAST, EUROPATFULL via EAST, CAplus, Medline

Reviewed prior application(s) : see the BIB data sheet

Search terms:

Inventor(s) : e.g. Dahlback B?/au

Factor V and mutation or polymorphism?

Thrombosis

Inherited APC resistance

Hybridization

Classes/Subclasses searched : 435/6; 536/23.1, 24.3